RESPONSE AND REMARKS

CLAIM REJECTIONS UNDER SECTION 101

In the Office Action, Claims 1-21, 27, 60-65, 100-103 and 138-141 were rejected under 35 U.S.C. §101. *Office Action*, Topic Nos. 1-6, pgs. 2-3.

RESPONSE REMARKS REGARDING CLAIM REJECTIONS UNDER SECTION 101

The rejections under Section 101 have been seriously considered. The Claims have been amended to more distinctly claim the claimed invention. It is respectfully asserted, for the reasons given, and under the authorities cited, below, that the amended Claims are patentable subject matter under Section 101.

It is respectfully asserted that amended independent Claims 1 and 138, and their respective dependent claims, Claims 2-21 and 139-140, are each directed to a computer system that positively recites structure (e.g., "computer device"), and are therefore patentable under Section 101.

It is respectfully asserted that amended Claims 100-103 and 141 are directed to a computer program product comprising a computer readable program code embodied on a computer usable medium and that is adapted to be executed for the limitations that are the subject of those respective Claims. It is respectfully asserted that Claims 100-103 and 141 are therefore directed to patentable subject matter under Section 101 (*See e.g., MPEP* 2106.1 (stating that "[w]hen functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.")).

In addition to other ways of demonstrating claimed subject matter as patent eligible under Section 101, the Federal Circuit has held that "[a] claimed process is *surely* patent-eligible under §101 if: (1) it is tied to a particular machine or apparatus, *or* (2) it transforms a particular article into a different state or thing." *In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008) (*en banc*; petition for *certiorari* pending) (emphasis added).

It is respectfully asserted that, for example, Claims 60, 62 and 65, and their respective dependent claims, Claims 61 and 63-64, meet the *Bilski* machine-or-

transformation test in that those Claims are directed to a particular computer. In the present office action, the Examiner argues that Claims 60-65 do not meet the *Bilski* machine or transformation test because the computer for return processing is not tied to the process steps (i.e. "The computer in the preamble is not positively recited and therefore lends itself to being insignificant extra-solution activity..."). Applicants have amended independent Claim 60 to further tie the method steps to a particular machine by reciting "the computer" in the body of the claim. Accordingly, it is respectfully asserted that the claimed "... computer for online merchandise return shipping ..." of amended independent Claims 60, 62, and 65, and their corresponding dependent Claims 61 and 63-64, meets the particular-machine prong of the *Bilski* machine-or-transformation test and those Claims are therefore patent eligible under Section 101.

It is respectfully asserted that Claim 27 meets the *Bilski* machine-or-transformation test in that Claim 27 has been amended to positively recite one or more computer devices ("... one or more online merchandise return computers ..."). Further, it is respectfully asserted that Claim 27 meets the *Bilski* machine-or-transformation test in that Claim 27 expressly recites "the ... computer system" in the body of the claim. It is therefore respectfully asserted that Claim 27 is therefore patent eligible under Section 101.

In addition, it is respectfully asserted that amended independent Claims 1 and 138 are tied to a particular machine. For example, Claim 1 is directed to an "online merchandise return computer system ... comprising ... at least one computer device ..." and claims various limitations involving other particular computer devices, such as, for example, Claim 1 recites a limitation involving an "... online retail computer system [that] compris[es] at least one remote computer device that is remote from the at least one computer device of the online merchandise return computer system ...." Claim 138 is directed to a computer system that comprises a computer device and claims various limitations involving another particular computer device, e.g., "... a consumer computer device ...." Accordingly, it is respectfully asserted that amended independent Claims 1 and 138 are tied to a particular machine, and therefore, even if those Claims were interpreted to be directed to a process, those Claims would meet the particular-machine

prong of the *Bilski* machine-or-transformation test and are therefore patent eligible under Section 101.

CLAIM REJECTIONS UNDER SECTION 103(a)

In the Office Action, Claims 1-10, 19-21, 60-65 and 100-102 were rejected under 35 U.S.C. §103(a) as being unpatentable over Schwab et al. (U.S. Patent Application Publication No. U.S. 2002/0019777; "*Schwab*") in view of Siegel (U.S. Patent Application Publication No. U.S. 2004/0143519; "*Siegel*"), Junger (U.S. Patent No. 6,269,344, "*Junger*") and Kara (U.S. Patent No. 6,233,568, "*Kara*"). *Office Action*, Topic Nos. 9-25, pgs. 4-8.

Except for the previously above-identified rejections under Section 101, the Office Action failed to state further grounds for rejecting Claims 11-12, 27, 62-65, 103, and 138-141. Instead, the Office Action states only that "[w]ith respect to Claims 10-12, 27, 62-65, 103, and 138-141: See Kara, Figure 8 with corresponding detailed description." *Office Action*, Topic No. 23, p. 8.

In the Office Action, Claims 13-21, 27, and 65 were rejected under 35 U.S.C. §103(a) as being unpatentable over Schwab, Siegel, Junger and Kara "as applied to Claim 11 above", and further in view of UPS® Service Guide (www.ups.com; "*UPS*"), FedEx® Services (www.fedex.com; "*FedEx*") and Barnett et al. (U.S. Patent No. 6,369,840; "*Barnett*"). *Office Action*, Topic Nos. 26-29, pgs.8-9.

RESPONSE REMARKS REGARDING CLAIM REJECTIONS UNDER SECTION 103(a)

The rejections of the Claims have been carefully considered. Claims 22-26, 28-59, 66-99, 104-137, and 142-169 were previously cancelled.

A previously-filed Declaration under 35 U.S.C. §132 by David Allison Bennett, currently with iShip Inc. (a fully owned subsidiary of United Parcel Service of America, Inc., which is a fully owned subsidiary of United Parcel Service, Inc.), one of the assignees of the above-identified patent application ("*Bennett Declaration*" or "*Bennett Decl.*"), is referred to herein.

A Declaration under 35 U.S.C. §132 by William W. Smith III ("*Smith Declaration*" or "*Smith Decl.*"), also currently with iShip Inc., is referred to herein and is concurrently filed herewith.

It is respectfully asserted, for the reasons given and authorities cited below, and in view of the evidence of nonobviousness provided by the *Bennett Declaration*, and the evidence in support of nonobviousness provided by the *Smith Declaration*, that the application is in condition for allowance.

The References of Record Fail to Disclose, and the Office Action Fails to Cite Any Reference or Combination of References That Discloses, a Display to a Consumer of a Set of Carriers That Were Pre-Selected by a Merchant From a List of Available Carriers for Subsequent Use by the Consumer for a Shipment by the Consumer to the Merchant of a Returnable Item

It is respectfully submitted that the Office Action fails to identify any reference or combination of references that discloses the limitations claimed in one way or another by independent Claims 1, 27, 62, 65, 100, 103, 138, and 141, as amended, for displaying, or generating a display, to a consumer of a set of carriers [and in some cases, services] that have been pre-selected by a merchant from a list of available carriers [and in some cases, services] for subsequent selection and use by the consumer in return shipping of an item of merchandise that the consumer had purchased from the merchant.

In particular, amended independent Claim 1 recites a merchant-selected display of carriers to a consumer as follows:

> ... receive a pre-selection by a particular online merchant of a set of carriers from a list of available carriers for use by consumers of merchandise sold by the particular online merchant for return shipping of returnable merchandise; ...and
> ... if the particular respective item of merchandise is returnable, generate a display to the display device configured for communication with the remote consumer computer device associated with the consumer, the display comprising information corresponding to the set of carriers that was pre-selected by the particular online merchant.

Amended independent Claim 27 similarly recites a merchant-selected display of

carriers to a consumer as follows:

> ... the set of carriers and the set of services being selected by the computer system for display according to a pre-selected set of carriers that was pre-selected through the online merchandise return computer system by the merchant from a list of available carriers and according to a set of return policy rules input by the merchant ....

Similarly, amended independent Claim 62 recites a merchant-selected display of carriers to a consumer as follows:

> *collecting by the computer, a set of return policy rules input by a merchant through a merchant computer device, the set of return policy rules comprising an identification by the merchant of a set of carriers that may be used by a consumer for a return shipping of an item of merchandise to the merchant*, the set of carriers being selected by the merchant from a list of available carriers;
> ... and
> in response to the merchandise return request, generating by the computer, a display to a display device configured for communication with the remote consumer computer device, the display comprising a representation of the set of carriers identified by the merchant according to the return policy rules for use by the consumer for shipping the particular item of merchandise to the merchant.

It is further respectfully submitted that, in one way or another, independent Claims 65, 100, 103, 138 and 141 similarly recite a merchant-pre-selected display of carriers to a consumer.

In rejecting Claims 1-10, 19-21, 60-65 and 100-102, the Office Action conceded that *Schwab*, *Siegel* and *Junger* "... fail to disclose[] displaying multiple carriers for use by the user to ship the item to the merchant" (*Office Action*, Topic No. 21, pgs. 6-7), but asserts instead that *Kara* "... discloses the use of a system used to select a carrier for shipment and calculating shipping rates for a plurality of carriers ...." *Office Action*, Topic No. 21, p. 7. The Office Action then concludes that "[i]t would have been obvious ... to modify Schwab, to include the ability to select a carrier and calculate the shipping rates for the carriers, according to Kara, in order ... for the user to make an informed choice as to the most preferable method of shipment. (See Kara, abstract)." *Office Action*, Topic No. 21, p. 7.

It is respectfully asserted that *Kara*, even when considered in combination with the other cited references, fails to disclose the combination of limitations claimed in one

way or another by amended independent Claims 1, 27, 62, 65, 100, 103, 138, and 141 for displaying, or generating a display, to a consumer that includes a subset of carriers that have been pre-selected by a merchant from a list of available carriers for use by the consumer. In particular, it is respectfully asserted that _Kara_'s disclosure of shipping rates for a plurality of carriers comprises only a static, system-defined list of carriers. It is respectfully asserted that there is no disclosure in _Kara_ that the carriers that appear in the static _Kara_-system-defined list of carriers were pre-selected by a merchant from a list of available carriers to appear in the _Kara_-system-defined list. Further, it is respectfully asserted that there is no disclosure in _Kara_ of, for example, receiving a pre-selection by a merchant of carriers and then displaying to a merchandise-returning consumer, information regarding those pre-selected carriers such as claimed, for example, by amended Claim 1.

The Office Action asserts that "... all of the method steps are known in Schwab [sic], Siegal [sic], Junger and Kara. The only difference is the combination of 'old steps' into one method of returning and allowing the user to choose the carrier. Thus, it would have been obvious to one having ordinary skill in the art to display the carriers to the user as taught by Kara, in the return method of Schwab, Siegal [sic] and Junger, since the method of displaying multiple carriers which can be used to ship the return, is used to achieve predictable results of giving the user a choice." _Office Action_, Topic No. 21, p. 7 (citing "... KSR [127 S Ct. at 1739] 'The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.'....").

Yet further, the Office Action asserts that "the limitation of the set of carriers 'that was pre-selected by the particular online merchant from a list of available carriers' was not a positively recited step of the system and is done outside of the system ...." _Office Action_, Topic No. 22, p. 7.

It is respectfully asserted that the above-asserted position by the Office Action fails to consider, and fails to identify a single reference of record that discloses, the limitations claimed by Claim 100 for "..._collecting a set of return policy rules input by a merchant using the graphic user interface_, the set of return policy rules comprising an identification of at least one item as a policy rule exception, and _the set of return policy_

rules further comprising an identification by the merchant of a set of carriers and delivery services offered by each carrier of the set of carriers selected by the merchant from a list of available carriers and a list of available delivery services, said set of carriers and delivery services for subsequent selection by a consumer for use by the consumer to ship a return of merchandise ...."

It is respectfully asserted that the above-asserted position by the Office Action fails to consider, and fails to identify a single reference of record that discloses, the limitations claimed by Claim 103 for "...generating in response to said merchandise return request, a display of an interactive graphic comparison of shipping rates for the return request for shipping a package containing an item of merchandise to be returned, said display showing a shipping rate for each service of a set of services offered by each carrier of a set of carriers, *the set of carriers and the set of services being selected by the computer system for display according to a set of return policy rules input by a merchant, said set of return policy rules comprising a set of carriers pre-selected by the merchant from a list of available carriers ....*"

Yet further, it is respectfully asserted that a pre-selection by the particular online merchant from a list of available carriers is expressly recited, for example, by amended independent Claim 1 (which recites " ... receive a pre-selection by a particular online merchant of a set of carriers from a list of available carriers for use by consumers of merchandise sold by the particular online merchant for return shipping of returnable merchandise ...and ... if the particular respective item of merchandise is returnable, generate a display to the display device configured for communication with the remote consumer computer device associated with the consumer, the display comprising information corresponding to the set of carriers that was pre-selected by the particular online merchant ..."); *see also,* independent Claims 27, 62, 65, 138, and 141 for similar limitations.

As previously noted above, as compared to the limitations expressly recited by Claims 1, 27, 62, 65, 100, 103, 138 and 141, *Kara* merely discloses a static, system-defined list of carriers rather than a list that has been pre-selected by a merchant from a list of available carriers.

"[W]hen evaluating the scope of a claim, every limitation in the claim must be

considered. ... Instead, the claim as a whole must be considered." *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, (United States Patent and Trademark Office; *Official Gazette* Notices for November 22, 2005), § II.C (*citing Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981)).

Yet further, for the following reasons, it is respectfully asserted that amended Claims 1, 27, 62, 65, 100, 103, 138, and 141 claiming displaying a list of carriers to a consumer/user that has been pre-selected by a merchant through the system is non-obvious in view of, and useful over, the references of record. In particular, it is respectfully asserted that the holding in *KSR* does not condone an assertion of obviousness where, as here, some of the claimed elements have not even been shown to be disclosed by the references of record. Rather, "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements ...." *KSR*, 127 S.Ct. at 1741 (quoting with approval, *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).

In *KSR*, the Supreme Court acknowledged that "... inventions in most, if not all, instances, rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *KSR*, 127 S.Ct. at 1741. Accordingly, the *KSR* Court reiterated its caution against hindsight bias and *ex post* reasoning. *KSR*, 127 S.Ct. at 1742. *Accord Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc.*, 2008 U.S. App. LEXIS 6786, *14-*15 (Fed. Cir. March 31, 2008) (explaining that "a flexible TSM [teaching, suggestion, or motivation] test remains the primary guarantor against a non-statutory hindsight analysis ...."(citations omitted)).

Yet further, "... a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR*, 127 S.Ct. at 1741.

As compared to the static, *Kara*-system-defined list of carriers, it is respectfully asserted that various embodiments of the combination of limitations claimed by Claims 1, 27, 62, 65, 100, 103, 138, and 141 for displaying, or generating a display, to a consumer of carriers according to a pre-selection by a merchant for subsequent use by the consumer in shipping a return of an item to the merchant are distinguished from, patentable over, and would be useful over, *Schwab*, *Siegel*, *Junger*, *Kara* and the other

references of record, in that providing a Merchant with the ability to customize the list of available carriers [and delivery services] for customer shipping of returns, would allow the Merchant to assert control over return shipping quality and costs. *See also, e.g.*, *Specification*, p. 13, lines 21-29 (describing exemplary embodiments that would allow "… each eCommerce Merchant [to] … authorize return shipping options, selected by the Merchant from a plurality of services offered by a plurality of carriers, to which the Merchant's consumers will be given access by the System ….")

Moreover, it is respectfully asserted that such abilities for a Merchant to customize the list of available carriers [and delivery services] for customer shipping of returns, and to control return shipping quality and costs are features not provided by, and are useful over, *Schwab*, *Siegel*, *Junger*, or *Kara*, whether considered alone or in combination with any of the other references of record.

Accordingly, in view of the complete absence of the above-discussed limitations from any of the cited references, in accordance with the caution by the *KSR* Court against hindsight bias and *ex post* reasoning (*KSR*, 127 S.Ct. at 1742), and further in view of the mandate by the *Interim Guidelines* to consider every limitation of a claim as a whole, it is respectfully asserted that various embodiments of the combination of limitations claimed by Claims 1, 27, 62, 65, 100, 103, 138, and 141 for displaying, or generating a display, to a consumer of carriers according to a pre-selection by a merchant for subsequent use by the consumer in shipping a return of an item to the merchant is distinguished from, is nonobvious in view of, and is patentable over, the references of record, and that those Claims and the Claims dependent on them are therefore in condition for allowance.

An Online Retail System's Display of Potentially Returnable Items Comprising Shipped Items Purchased Through the Online Retail System is Patentably Distinct From the References of Record that Appear to Require a Customer to Either Physically or Electronically, Address or Appear at a Site Other Than the Website Through Which the Customer Purchased the Item to be Returned

The rejection asserted by the Office Action is suggesting that a consumer's physical return of an item to a physical return location as disclosed in both *Schwab* and *Junger*, in combination with a return request submitted through a third-party website as disclosed in *Siegel*, should be understood to disclose the facilitating of a consumer that had purchased an item of merchandise through a particular online retail computer system to input a merchandise return request into the same online retail computer system as claimed, for example, by independent Claim 1.

However, for the reasons described in more detail below, it is respectfully asserted that a particular online retail system's display of potentially returnable items comprising shipped items purchased through the particular online retail system as claimed by independent Claim 1 is patentably distinct from the references of record, including *Schwab*, *Siegel*, and *Junger* that appear to require a customer to either physically (in the cases of *Schwab* and *Junger*) or electronically (in the case of *Siegel*) return to a physical location or website other than the website through which the customer purchased an item to be returned.

As distinguished from the references of record, it is respectfully asserted that various embodiments of the limitations of amended Claim 1 of the present application, for example, would allow a consumer to input a merchandise return request into the same online retail computer system through which the consumer had purchased the item to be returned. In particular, amended Claim 1 recites:

> receive a pre-selection by a particular online merchant of a set of carriers from a list of available carriers for use by consumers of merchandise sold by the particular online merchant for return shipping of returnable merchandise;
> receive from an online retail computer system of a particular online merchant, an indication from the online retail computer system of a shipment on behalf of the particular online merchant of an at least one item of merchandise purchased by a consumer through the online retail computer system, the online retail computer system comprising at least one remote computer device that is remote from the at least one computer device of the online merchandise return computer system;
> in response to the indication of the shipment, designate through the online retail computer system, the at least one item as a potentially returnable item;
> receive through the online retail computer system, a request by the consumer for an identification of potentially returnable items;
> in response to the request, generate a display through the online retail computer system to a display device adapted for communication with a remote

consumer computer device associated with the consumer, the display comprising an identification of potentially returnable items, the identification of potentially returnable items comprising an identification of the at least one item of merchandise, and further comprising a respective interactive means associated with each respective item of merchandise identified in the identification of potentially returnable items, each respective interactive means being configured for designating a return of each respective item of merchandise identified in the identification of potentially returnable items ....

The Office Action asserts that "Schwab discloses requesting the return of an item to an online retail system," and that "... everything is done online with Schwab." *Office Action*, Topic No. 32, p. 10. Further, citing the abstract of *Schwab*, the Office Action asserts that "Schwab discloses the use of an online merchant return computer system [which] ... the examiner considers ... to include both the merchant computer, as well as the third party/agent computer, due to the fact that they [sic] both computers cooperatively work together, to process and return a product ...." *Office Action*, Topic No. 10, p. 4.

However, as compared to allowing a consumer that had purchased an item of merchandise through a particular online retail computer system to input a merchandise return request into the same online retail computer system as would be provided by an exemplary embodiment of limitations claimed, for example, by Claim 1, it is respectfully asserted that *Schwab* discloses a consumer having to first deliver the item and a document (a "ReturnCERT 501") to a local return agent. *See, e.g., Schwab*, Paragraph 0052. It is respectfully asserted that with *Schwab*, only after the item had been physically returned to a local return agent would anything about the return be entered into any system, and then, it would be entered by the local return agent, not by the consumer as claimed, for example by Claim 1. *See, e.g., Schwab*, Paragraph 0052 (The third party 60 would then scan ... the ReturnCERT .... Or enter the ReturnCERT ... data into his computer system ....").

Accordingly, it is respectfully asserted that the assertion by the Office Action that "... everything is done online with Schwab ..." (*Office Action*, Topic No. 32, p. 10) does not consider the perspective of the consumer, which is central to the claimed limitations of, for example, Claim 1.

Similarly, as compared to allowing a consumer that had purchased an item of merchandise through a particular online retail computer system to input a merchandise return request into the same online retail computer system as would be provided by an exemplary embodiment of limitations claimed, for example, by Claim 1, it is respectfully asserted that *Siegel* discloses that in order for a user of *Siegel* to view a *Siegel* listing of a particular purchase, the user would need to have previously made the purchase through another website, namely, through the website of an online merchant (*see, e.g., Siegel*, ¶0026 ("The server system adds transaction listing 101 and detailed item description 104 to each web page for the item(s) the user has purchased from various retailers."); *see also, e.g.*, FIG. 1A), and would then subsequently need to log in to the *Siegel* website, not the website from which the relevant purchase had been made, in order to view the *Siegel* listing of purchases made by the user from various retailers and in order to arrange for a return of the item. *See, e.g., Siegel*, ¶0008 ("the method preferably includes identifying a user, gathering a transaction history associated with the identified user and displaying the transaction history associated with the identified user").

The Office Action concedes that "... Schwab and Siegal [sic] disclose the initiation of the return being through a third party website, and fails [sic] to disclose it being through the online retail computer system ..." (*Office Action*, Topic No. 20, p. 6), but asserts instead that "Junger discloses the use of a return system at a local site, then this information is sent to a remote approval computer system for authorization of the return (Column 2, lines 46-67)." *Office Action*, Topic No. 20, p. 6.

The Office Action further states that even though "... Schwab ... discloses the use of a third party which does the processing, no[t] the same online merchant system which the item was purchased through ...[,] Junger is used only to show that instead of using a third party, that a person can initiate a return directly through the retailer/merchant, as opposed to a third party. The online merchant request is being taught by Schwab, not by Junger." *Office Action*, Topic No. 32, p. 10.

It is respectfully asserted, however, that rather than supporting the obviousness rejection, *Junger* serves instead to exemplify the problem faced by a consumer prior to the present invention. It is respectfully asserted that, in particular, *Junger* describes the

problem of a consumer having to physically return an item to a physical return location that existed prior to the present invention. *See, e.g., Junger*, col. 3, lines 48-50 (disclosing, with reference to its FIG. 1, that "a regional warehouse 1 operated by a large retail chain collects product returns from local retail stores 3A and 3B."; *Junger*, col. 3, lines 61-64 (disclosing that "[a]fter the returned products arrive at the regional warehouse 1, they are sorted by manufacturer and/or product, and are shipped from the regional warehouse 1 to the manufacturer warehouse 5 for credit or replacement.").

That is, with *Junger*, as with *Schwab*, the user must have already delivered the returned item to a physical return location, such as a local retail store, before there is any entry into any system regarding the return. Accordingly, it is respectfully asserted that *Junger*, like *Schwab* and *Siegel*, does not disclose, anticipate, teach or suggest facilitating a consumer that had purchased an item of merchandise through a particular online retail computer system to input a merchandise return request into the same online retail computer system as claimed by independent Claim 1.

Rather, for the reasons given above, it is respectfully asserted that the assertion by the Office Action of obviousness fails to assert a single reference, or a combination of references, that discloses, anticipates, teaches or suggests allowing a consumer that had purchased an item of merchandise through a particular online retail computer system to input a merchandise return request into the same online retail computer system as claimed by independent Claim 1.

Yet further, contrary to the inference by the Office Action that *KSR* supports the reasoning of the rejections of Claim 1, it is respectfully asserted that the holding in *KSR* does not condone an assertion of obviousness where, as here, some of the claimed elements have not even been shown to be disclosed by the references of record. *See, e.g., KSR*, 127 S.Ct. at 1741-1742 (quoting *In re Kahn* that "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements ...." (quoting with approval, *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)), acknowledging that "... inventions in most, if not all, instances, rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known..." and reiterating its caution against hindsight bias and *ex post* reasoning).

Accordingly, in view of the complete absence of the above-mentioned claimed limitations from any of the references of record, in accordance with the caution by the *KSR* Court against hindsight bias and *ex post* reasoning (*KSR*, 127 S.Ct. at 1742), and further in view of the mandate by the *Interim Guidelines* to consider every limitation of a claim as a whole, it is respectfully asserted that various embodiments of the combination of limitations claimed by Claim 1 is nonobvious in view of, and is patentable over, the references of record, and that those Claims and the Claims dependent on them are therefore in condition for allowance.

For the above-given reasons and under the above-cited authorities, because it is respectfully asserted that independent Claim 1 is patentably distinct from and patentable over the references of record, it is therefore respectfully asserted that the Claims that are dependent on Claim 1, namely, Claims 2-21, are therefore also patentably distinct from and patentable over the references of record.

None of the References of Record Disclose, and the Office Action Fails to Cite any References that Disclose, a Display Through an Online Merchant's Retail Computer System of an Identification of Potentially Returnable Items Comprising *Shipped* Items that were Purchased by a Consumer Through the Online Merchant's Retail Computer System, in that the References of Record Appear to Generate as Lists of Returnable Items, Items That Were Purchased, but Not Necessarily Shipped

It is respectfully asserted that none of the references of record, including *Schwab* and *Siegel*, whether considered alone or in combination, disclose, anticipate, teach or suggest the combination of limitations of independent Claim 1 for "...generat[ing] ... a display ... comprising an identification of potentially returnable items ... compris[ing] an identification of [an] at least one item of merchandise [that was purchased by the consumer through the online retail computer system and *shipped*] ...."

The Office Action asserts that even though *Schwab* "... fails to disclose the use of a display, which displays each item of a previous order and an interactive means associated with each item in each order, to return an item ... Siegel discloses a return system where a user's previous orders along with each item in the order are displayed,

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and each item is associated with a checkbox, which the examiner considers to be an interactive means, to submit a return request ...." *Office Action*, Topic No. 19, p. 6 (citing Figure 1A of *Siegel* and the "corresponding detailed description").

However, as compared to the above-recited limitations claimed by Claim 1, it is respectfully asserted, for the reasons described further below, that a computer system such as claimed by Claim 1 that lists as potentially returnable, items that have already been shipped, is patentably distinct from, and patentable over, a system such as is asserted by the Office Action as disclosed in *Siegel* that only lists items that have been *purchased*, but not necessarily shipped. *See, e.g., Siegel*, ¶[0008] and ¶[0026] (disclosing a system that gathers from various retailer systems/databases information about *purchase* transactions by a user) (emphasis added); *Siegel*, FIG. 2, element 215 ("Transaction Database"); *Siegel*, FIG. 5, element 535 ("Gather Transaction History for User"); *Siegel*, ¶0045. *Siegel* explains that the transactions are gathered from a collection of databases for multiple retailers and other sources. *Siegel*, ¶0045 ("... transactions database 215 can be maintained at another location as well as created real-time from a collection of databases located at member retail sites, credit card sites or other data bases."); *see also, e.g., Siegel*, ¶0008 ("the method preferably includes identifying a user, gathering a transaction history associated with the identified user and displaying the transaction history associated with the identified user").

When a user accesses the *Siegel* system, the *Siegel* system presents a list of purchase transactions by the user gathered from various retailer databases and systems. *See, e.g., Siegel*, ¶[0008] and ¶0026]. However, it is respectfully asserted that there is no disclosure in *Siegel* regarding whether the *Siegel*-presented items purchased by the user have been shipped. *See also Bennett Decl.*, ¶ 8. It is therefore respectfully asserted that *Siegel* does not disclose differentiating between items that have been purchased, but not yet shipped, and items that have been purchased and shipped to the user. *See also Bennett Decl.*, ¶ 9.

Therefore, it is respectfully asserted that a *Siegel* listing for a particular user may contain both items that have been purchased but not yet shipped (and therefore not yet received by the user, and therefore, that are not yet return shippable), as well as items that have been purchased and shipped to the user. *See also Bennett Decl.*, ¶ 9. It is

therefore respectfully asserted that a user of a _Siegel_ display of a listing of an item that has not yet been shipped could incorrectly select such an item for return. _See also_ _Bennett Decl._, ¶ 9.

In order to discuss the types of issues that could result from such an incorrect selection, it may be helpful to consider a period of time during which a user may be involved in a relatively high number of purchases, such as, for example, during Christmas. During high transaction activity periods, it is respectfully asserted that a user may make repeated purchase of a same or similar item. _See also_ _Bennett Decl._, ¶ 10. It is respectfully asserted that a user may receive one such item and want to return it. However, it is respectfully asserted that the corresponding _Siegel_ display would list the item that the user had already received as well as other item(s) of the same or similar type that the user had purchased but had not yet been received, or that, perhaps, had been shipped to others. _See also_ _Bennett Decl._, ¶ 10.

Presented with such a list that co-mingles both shipped and not-yet-shipped items, it is respectfully asserted that the _Siegel_ user may indicate return of an item that was not yet been shipped by mistake. _See also_ _Bennett Decl._, ¶ 10. It is respectfully asserted that, for items that may have a perishable life, for example, such an erroneous "return" could result in improper return processing by the merchant. _See also_ _Bennett Decl._, ¶¶ 10-12. For example, it is respectfully asserted that such an erroneous return could require an additional reconciliation action by the merchant to correct what was expected to be returned, to what was actually returned. See, e.g., _Bennett Decl._, ¶ 11. Or, as another example, it is respectfully asserted that such an erroneous return could result in mistakenly allowing return of an already expired, perishable item, and could consequently result in a loss of money for the merchant. See, e.g., _Bennett Decl._, ¶ 12.

Finding the _Bennett_ Declaration unpersuasive, the Office Action states that "[t]he affidavit ... is insufficient to overcome the rejection of [the] claims ...." _Office Action_, Topic No. 30, p. 9. However, it is respectfully asserted that, notwithstanding the finding by the Office Action that the _Bennett_ Declaration is not persuasive, the Office Action fails to respond to the assertions that there is no disclosure in _Siegel_ regarding whether the _Siegel_-presented items purchased by the user have been shipped. Rather, the Office Action states that "... the claims only recite items where are 'potentially

returnable'." _Office Action_, Topic No. 30, p. 10. However, for the reasons given below, that is not the case. Rather, Claim 1, for example, expressly claims that potentially returnable items are items for which an indication of a shipment has been received.

In particular, Claim 1, as amended, recites "...receive from an online retail computer system of a particular online merchant, an indication ... of a _shipment_ ...of an at least one item of merchandise purchased by a consumer through the online retail computer system ...." (Emphasis added). Claim 1 further recites "...in response to the indication of the _shipment_, designate through the online retail computer system, the at least one item as a potentially returnable item ...." (Emphasis added). These two limitations clearly relate to items that have been shipped.

It is respectfully asserted, in view of the limitations recited by Claim 1, that a "potentially returnable item" is an item for which "an indication .. of [a] shipment" had been received from the online retail computer system. Further, it is therefore respectfully asserted that the Office Action fails to identify a reference, or any combination of references, that discloses, anticipates, teaches or suggests, as required by MPEP §2143 for a _prima facie_ case of obviousness, the combination of limitations of independent Claim 1 for "...generat[ing] ... a display ... comprising an identification of potentially returnable items ... compris[ing] an identification of [an] at least one item of merchandise [that was purchased by the consumer through the online retail computer system and _shipped_] ...."

It is respectfully asserted that various embodiments of the limitations of Claim 1 for designating items that have been shipped, not merely purchased, as potentially returnable items, would be useful over the _Siegel_ system in that only shipped items would be listed as potentially returnable, thereby preventing possibly confusing listings of items purchased but not yet shipped as potentially returnable, as would be possible under _Siegel_. _See also Bennett Decl._, ¶ 13. It is therefore respectfully asserted that Claim 1 is nonobvious in view of, and patentable over, the references of record.

For the above-given reasons, because it is respectfully asserted that independent Claim 1 is patentably distinct from the references of record, it is respectfully asserted that the Claims that are dependent on Claim 1, namely, Claims 2-

21, are therefore also patentably distinct from, and patentable over, the references of record, and are therefore in condition for allowance.

None of the References of Record Disclose, and the Office Action Fails to Cite any References that Disclose, Generating a Graphic User Interface for Input of Return Policy Rules and That is Adapted for Receiving Input Identifying at Least One Item as an Exception to Standard Return Policy Rules as Claimed by Claim 100

It is respectfully asserted that the limitations for generating a graphic user interface adapted for receiving input of return policy rules as claimed by independent Claim 100 are patentably distinct from the references of record. In particular, Claim 100 recites:

> generating a graphic user interface for input of return policy rules, the graphic user interface being configured for receiving input identifying an item as an exception to standard return policy rules;
> collecting a set of return policy rules input by a merchant using the graphic user interface, the set of return policy rules comprising an identification of at least one item as a policy rule exception, and the set of return policy rules further comprising an identification by the merchant of a set of carriers and delivery services offered by each carrier of the set of carriers selected by the merchant from a list of available carriers and a list of available delivery services, said set of carriers and delivery services for subsequent selection by a consumer for use by the consumer to ship a return of merchandise ....

It is respectfully asserted that neither _Schwab_, nor any of the other references of record, disclose, anticipate, teach or suggest the recitation of Claim 100 of the limitation for "...generating a graphic user interface for input of return policy rules, the graphic user interface being configured for receiving input identifying an item as an exception to standard return policy rules...".

The Office Action cites _Schwab_ as disclosing "... the use of a set of return questions ... and processing the return according to the rules ...." _Office Action_, Topic No. 16, p. 5 (citing paragraphs [0012] and [0053] of _Schwab_).

However, as compared to the combination of limitations claimed by Claim 100, it is respectfully asserted that _Schwab_ does not disclose allowing a user to identify exceptions to a standard return policy, and that _Schwab_ does not disclose storing any

data relating to exceptions to return policy rules.

In particular, notwithstanding the assertions by the Office Action, Applicants respectfully disagree that _Schwab_ discloses, or that the Office Action has cited a reference that discloses, generating a graphic user interface as claimed by Claim 100 or collecting a set of return policy rules input as claimed by Claim 100. Paragraph [0012] of _Schwab_ cited by the Office Action describes in pertinent part a:

> ... second stage called parameterization, [that] allows the third party to review parameters defined by the merchant ... that establishes the conditions for an acceptable return. This can include, but is not limited to, physical descriptions of the goods, quantity counts, packaging, general return policies, re-stocking fees, date of original purchase, warranties, acceptable physical condition, return window (dates) and any other data that enables the third party to act for the merchant in establishing whether or not the merchandise to be returned meets the conditions established for the return and may be accepted as a return. ... The parameterization process is accomplished by the third party reviewing material supplied by the merchant seller electronically via the electronic link established in the authentication stage described above.

Paragraph [0053] of _Schwab_ cited by the Office Action describes in pertinent part that:

> At this point, where the return request appears valid, the third party 60 would initiate a Parameter Request 605 utilizing his computer system 603, which is electronically connected to the merchant 40. The merchant 40 would then automatically provide the Return Parameters 607 back to the third party 60. These parameters or conditions for the return 607 are then reviewed by the third party 60 and the product return 503 is compared to the parameters 607 provided by the merchant 40. If the product 503 and ReturnCERT 501 satisfies the Return Parameters 607 specified, the third party 60 initiates a Parameters Accepted 609 communication to the merchant 40. This step is referred to as Presentation, since it establishes the compilation and presentation of all parameters of interest to a merchant 40 regarding a product return request. Once the third party 60 provides this information to the merchant 40, along with his indication that the product 503 and ReturnCERT 501 comply with the return parameters 607, the merchant 40 must decide whether or not to accept the return request. This can either be done manually or through an automated or pre-established method.

It is respectfully submitted that the above-quoted disclosures of _Schwab_ fail to disclose generating a graphic user interface for input of return policy rules as claimed by Claim 100 or collecting a set of return policy rules input as claimed by Claim 100.

Further, it is respectfully submitted that the above-quoted disclosures of _Schwab_

fail to disclose a graphic user interface that is adapted for receiving input identifying an item as an exception to standard return policy rules. In particular, although Paragraph [0012] of _Schwab_ discloses parameters such as "physical descriptions of the goods, quantity counts, packaging, general return policies, re-stocking fees, date of original purchase, warranties, acceptable physical condition, return window (dates)," it does not disclose identifying items as exceptions to return policy rules.

In view of the mandate by the _Interim Guidelines_ to consider every limitation of a claim as a whole, it is respectfully asserted that various embodiments of the combination of limitations claimed by Claim 100 would be useful over the references of record in that the claimed exception definition and processing would provide a merchant with the ability to establish general return rules for broad categories of merchandise and would allow them to designate certain items as exceptions to the general return rules.

For the above-given reasons, it is respectfully asserted that independent Claim 100 is patentably distinct from the references of record, and is therefore respectfully asserted that the Claims that are dependent on Claim 100, namely, Claims 101-102, are therefore also patentably distinct from the references of record.

None of the References of Record Disclose Return Policy Rules
Comprising a Set of Return Questions as Claimed by Claims 2, 61 and 65

The Office Action cites _Schwab_ as disclosing "... the use of a set of return questions ... and processing the return according to the rules ...." _Office Action_, Topic No. 16, p. 5 (citing paragraphs [0012] and [0053] of _Schwab_).

Applicants respectfully disagree that _Schwab_ discloses the use of a set of return questions as asserted by the Office Action. Paragraph [0012] of _Schwab_ cited by the Office Action describes in pertinent part a:

> ... second stage called parameterization, [that] allows the third party to review parameters defined by the merchant ... that establishes the conditions for an acceptable return. This can include, but is not limited to, physical descriptions of the goods, quantity counts, packaging, general return policies, re-stocking fees, date of original purchase, warranties, acceptable physical condition, return window (dates) and any other data that enables the third party to act for the merchant in establishing whether or not the merchandise to be returned meets the conditions established for the return and may be accepted as a return. ... The parameterization process is accomplished by the third party reviewing material

supplied by the merchant seller electronically via the electronic link established in the authentication stage described above.

Paragraph [0053] of _Schwab_ cited by the Office Action describes in pertinent part that:

> At this point, where the return request appears valid, the third party 60 would initiate a Parameter Request 605 utilizing his computer system 603, which is electronically connected to the merchant 40. The merchant 40 would then automatically provide the Return Parameters 607 back to the third party 60. These parameters or conditions for the return 607 are then reviewed by the third party 60 and the product return 503 is compared to the parameters 607 provided by the merchant 40. If the product 503 and ReturnCERT 501 satisfies the Return Parameters 607 specified, the third party 60 initiates a Parameters Accepted 609 communication to the merchant 40. This step is referred to as Presentation, since it establishes the compilation and presentation of all parameters of interest to a merchant 40 regarding a product return request. Once the third party 60 provides this information to the merchant 40, along with his indication that the product 503 and ReturnCERT 501 comply with the return parameters 607, the merchant 40 must decide whether or not to accept the return request. This can either be done manually or through an automated or pre-established method.

Notwithstanding the above-quoted disclosures of _Schwab_, it is respectfully asserted that the above-quoted disclosures of _Schwab_ fail to disclose, anticipate, teach or suggest the recitation by _e.g._, Claims 61 and 65, of the limitations "...the set of return policy rules comprising: a set of return questions, and a set of anticipated return question responses corresponding to each of said return questions ...". _See also_ Claim 2 for similar limitations regarding return questions.

The Office Action asserts in response that "... Schwab discloses a parameter request, reference numeral 605, product return parameters, such as description of product and condition of product. Given the broadest reasonable interpretation the examiner considers these to be equivalent to questions...." _Office Action_, Topic No. 35, p. 11.

However, it is respectfully asserted that none of the cited references, including _Schwab_, disclose, anticipate, teach or suggest a subset of the return policy rules that are input through the system by a merchant that comprises: a set of return questions for eventual presentation to a returning consumer; and a set of anticipated return question responses that correspond to each of the return questions that can be expected to be

input by the returning consumer.

In particular, even assuming for the sake of argument only that the _Schwab_ product return parameters asserted by Office Action could reasonably be interpreted to comprise return questions, it is respectfully asserted that there is no disclosure in _Schwab_ that such product return parameters are input through the system by a merchant. Further, it is respectfully asserted that there is no disclosure by _Schwab_ of input by a merchant through the system of a set of anticipated return question responses.

As compared to a merchant-tailored input of a set of return questions and a set of anticipated return responses, assuming for the sake of argument only that the _Schwab_ product return parameters could reasonably be interpreted to comprise return questions, it is respectfully asserted that the _Schwab_ product return parameters may comprise static, hard-coded logic. It is respectfully asserted that an exemplary embodiment of the limitations claimed, for example, by Claim 61 would be useful over static, hard-coded logic, in that such an embodiment would facilitate a merchant's input of questions and responses for tailoring the system's analysis of merchandise returnability.

Yet further, it is respectfully asserted that none of the cited references disclose "...each return response rule identifying an anticipated return question response as comprising either an acceptable response or unacceptable response ..." as claimed by amended Claims 2 and 65. It is respectfully asserted that an exemplary embodiment of such limitations would further facilitate a merchant's definition of returnability of merchandise.

For the above-given reasons, it is respectfully asserted that Claims 2, 61 and 65 are patentably distinct from, and patentable over, the references of record and are therefore in condition for allowance.

None of the References of Record Disclose Generating a Credit to a Credit Card Account in Response to a Return Request as Claimed by Claim 60

It is respectfully asserted that neither _Schwab_, nor any of the other cited references, disclose, anticipate, teach or suggest the combination of limitations recited

by amended Claim 60 of "...in response to receiving the indication of receipt by the merchant of the item of merchandise, generating by the computer, a credit to the credit card account."

The Office Action cites _Schwab_'s abstract and paragraphs 0003-0006 as disclosing "[i]ssu[ing] a credit to the user for the return." _Office Action,_ Topic No. 18, p. 5.

It is respectfully asserted that the portions of _Schwab_ cited by the Office Action describe a problem with e-commerce returns that existed prior to the present invention. In particular, _Schwab_ explains that "[i]n the commercial practices of e-commerce .... [w]here the buyer decides to return [a] purchase, ... the internet buyer must ... verify[y] [that] the credit card account of the buyer has been properly credited ... this arrangement requires time for the buyer to arrange for the return ... and to receive credit ...." _Schwab_, ¶[0003].

As compared to an e-commerce return to an Internet merchant, _Schwab_ describes a way for a consumer to physically return an item purchased through the Internet to a third-party agent and receive a credit through that agent. _See, e.g.,_ _Schwab_, Abstract (disclosing "... enable[ing] [an] agent, acting on behalf of the merchant, to issue financial credit instantly to the customer ...").

However, in its criticism of e-commerce returns, and in its description of an alternative third-party return approach, it is respectfully asserted that _Schwab_ fails to disclose a method using a computer, such as claimed by Claim 60, for:

> receiving by the computer, a merchandise return request input by a consumer to return an item of merchandise, the merchandise return request corresponding to an indication of a credit card account for crediting a refund amount for return of the item of merchandise, and the merchandise return request further corresponding to information about the item;
> comparing by the computer, information about the item to a set of return policy rules input by the merchant;
> approving by the computer, the item for return where information about the item is in accord with the set of return policy rules,
> receiving by the computer, an indication of receipt by the merchant of the item of merchandise returned by the consumer; and
> in response to receiving the indication of receipt by the merchant of the item of merchandise, generating by the computer, a credit to the credit card account.

It is therefore respectfully asserted that the combination of limitations recited by amended Claim 60 is not disclosed by the cited references.

For the above-given reasons, it is respectfully asserted that Claim 60 is patentably distinct from, and patentable over, the references of record, and that, therefore, the Claim that is dependent on Claim 60, namely, Claim 61, is also patentably distinct from, and patentable over, the references of record, and are therefore in condition for allowance.

None of the Cited References, Nor Any Combination of the Cited References, Disclose Generating a Display of an Interactive Graphic Comparison of Calculated Shipping Rates for Carriers Pre-Identified by a Merchant at the Intersection of Corresponding Delivery Dates and Times as Claimed by Claim 15

It is respectfully asserted that the combination of limitations recited by dependent Claim 15 (and the Claims on which it depends) is patentably distinct from, and patentable over, the references of record. In particular, dependent Claim 15 (and the Claims on which it depends) claims the generation of a display to a consumer of calculated shipping rates for delivery services by carriers that have been pre-identified by a merchant such that the rates are displayed at an intersection that coincides with a particular delivery date and a particular delivery time by which a particular delivery service by a particular carrier would deliver an item being returned by the consumer to a particular online merchant for the displayed shipping rate.

As described previously above, as compared to the static definitional parameters of the cited references, it is respectfully asserted that the definitional parameters for the claimed display, are dependent on claimed limitations. For example, it is respectfully asserted that as compared to the static display of carriers and delivery services disclosed by *Kara*, the claimed identification of carriers and delivery services is dependent on, because it is determined according to, a pre-selection of carriers by a merchant. It is therefore respectfully asserted that there is no such dependency disclosed in any of the cited references.

Further, as described further below, as compared to a static, calendar-basis display of events such as disclosed in _Barnett_, the claimed display of rates by dates and times is generated with respect to a particular shipping date for a particular return.

Yet further, as described further below, as compared to discrete delivery service/carrier-specific information such as disclosed by the _UPS_ and _FedEx_ references.

The Office Action concedes that _Kara_ does not specifically disclose the rates being calculated with respect to time, but asserts that "[b]oth UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day." _Office Action_, Topic No. 27, p. 8. The Office Action further asserts that "[i]t would have been obvious ... to include the time sensitive "urgency" services, as disclosed by FedEx® and UPS® , in order to ship thing [sic] and compete with a time advantage using guaranteed delivery times and to reduce costs, when delivery time is not of importance. (See Fed Ex Page 1)." _Office Action_, Topic No. 27, p. 8.

The Office Action further concedes that "Kara, UPS® and FedEx® fail to disclose the use of a graph which simultaneously displays a graph of shipping fees and services, where one axis being date and one axis being time and where each cell is located at the intersection of the date and time." _Office Action_, Topic No. 27, p. 8. The Office Action then asserts, though, that "Barnet [sic] discloses the use of a calendar which can be [used] for online purchasing of services (column 2, lines 63-67), where there is a graphical representation of date on one axis and time on another (See Figure 9)." _Office Action_, Topic No. 27, pgs. 8-9. The Office Action concludes that "[i]t would have been obvious ... to display the calculation of shipping rates, calculated by Kara, UPS® and FedEx®, in the format of a plurality of cells with date on one axis and time on another, as disclosed by Barnett, in order to provide a multi-layers system wherein different categories can be overlaid on one another providing a single integrated display that allows a user to order or purchase a system based on the calendar day and time (See Barnett, column 2)." _Office Action_, Topic No. 27, p. 9.

It is respectfully asserted that instead of contributing to the claimed limitations recited by Claim 15, the _UPS_ and _FedEx_ references depict the problem that a user

would face in trying to obtain comparison of shipping rates and delivery times and dates across multiple carriers and multiple delivery services offered by those carriers.

It is respectfully asserted that a user of _FedEx_ would encounter the description of _FedEx_ that different delivery times apply depending on the shipping particulars for shipping a particular parcel. For example, _FedEx_ explains that "FedEx Priority Overnight®" is for providing "...delivery by 10:30 a.m. the next business day to thousands of U.S. cities in our primary service are (noon to most of the rest)." _FedEx_, p. 1.

That is, in order for a _FedEx_ user to determine whether a parcel to be shipped using FedEx Priority Overnight® would result in delivery by 10:30 a.m. the next business day, or by noon the next business day (or some other time), the user would need to investigate whether the city to which the parcel was to be shipped was one of the "thousands" for which delivery would be provided by 10:30 a.m., or whether the city was one of the "most of the rest" for which delivery would be provided by noon, or whether the city was neither one of the "thousands" for which delivery would be provided by 10:30 a.m., or one of the "most of the rest" for which delivery would be provided by noon, in which case, the FedEx reference provides no indication of a delivery time guarantee. Moreover, whatever the result of the user's above-outlined investigation, the time for delivery determined by the user would apply only if the user elected to use the FedEx Priority Overnight® delivery service; the user would need to plod on with further investigation to determine a comparison of a delivery time if the user were to instead, for example, elect FedEx Standard Overnight® or FedEx 2Day(SM).

The above-described steps that a _FedEx_ user would have to take to determine the delivery time of a parcel to be shipped for any particular FedEx® service are evidence that _FedEx_ does not disclose the combination of limitations recited by Claims 15 (and the Claims on which Claim 15 depends).

Trying to obtain a comparison of projected delivery dates would also have required the _FedEx_ user to investigate the specific FedEx® rules as those rules pertained to the user's particular shipping requirements. That is, the information provided in _FedEx_ is only general information.

Regarding a date by which delivery would be expected, _FedEx_ explains that Saturday delivery is not available for the "FedEx Standard Overnight®" service. _FedEx_, p. 1. That is, if a parcel is shipped on a Friday using FedEx Standard Overnight®, because delivery on Saturday is not available for that service, the parcel would not be delivered until the following Monday, or if the following Monday were a holiday, by the following Tuesday. Therefore, in order for a delivery _date_ to be determined, a user of _FedEx_ would need to consult a calendar (mentally or visually) to determine the delivery date on which a parcel shipped via, e.g., FedEx Standard Overnight® should be delivered. For example, if the user was shipping a package on, _e.g._, a Friday, the user would need to identify the date of the following Monday, or if the following Monday were a holiday, the following Tuesday.

Yet further, in order for a delivery date to be determined, a user of _FedEx_, may, depending on the circumstances, need to consult a clock to determine the date of expected delivery of a parcel to be sent by FedEx Standard Overnight®. For example, if the user was shipping the package after a particular cut-off time, the package may not be delivered the following day -- that is, the package may be delivered two days after the shipment date.

The above-described steps that a _FedEx_ user would have to take to determine a delivery date of a parcel to be shipped, _e.g._, using FedEx Standard Overnight® are further evidence that _FedEx_ does not disclose the combination of limitations recited by Claims 15 (and the Claims on which Claim 15 depends).

Further still, if a user of _FedEx_ wanted to compare, across various FedEx® services, delivery dates and times of a particular parcel that the user wanted to ship, the user would need to determine a delivery date and time for each FedEx® service to be compared. The aforementioned steps that a _FedEx_ user would have to take to determine a cross-comparison with an indication of delivery dates and times for a parcel using only a single carrier, _e.g.,_ FedEx®, is yet further evidence that _FedEx_ does not disclose the combination of limitations recited by Claims 15 (and the Claims on which Claim 15 depends).

Turning to the _UPS_ reference, as with _FedEx_, _UPS_ teaches that, even for "guaranteed" services (_See, e.g., Office Action_, Topic 27, p. 8 (stating that "[b]oth UPS®

and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day.), different delivery times may apply depending on the shipping and/or delivery particulars for shipping and delivering a particular parcel. For example, for the UPS Next Day Air Early A.M.® delivery service, even though *UPS* states "Guaranteed Overnight by 8 A.M.", *UPS* clarifies that "[y]ou get guaranteed delivery by 8:00 a.m. to major U.S. cities and by 8:30 a.m. to *most* other U.S. cities (9:00 a.m. or 9:30 a.m. on Saturday)..." (emphasis added). That is, in order for delivery to be "Guaranteed Overnight by 8 A.M.", assuming the delivery was to occur Monday through Friday, the delivery address would need to be in one of the "major U.S. cities;" in order for delivery to be guaranteed by 8:30 a.m., the delivery address, if not in one of the "major U.S. cities", would need to be in one of the "*most* other U.S. cities..." (emphasis added).

As another example of guarantee-dependency on shipping particulars, for the UPS Next Day Air® delivery service, even though *UPS* states "Guaranteed Overnight by 10:30 AM", *UPS* clarifies that delivery is guaranteed "...by 10:30 a.m., noon, or end-of-day the next business day *depending on destination* (noon or 1:30 p.m. on Saturdays)." (emphasis added). That is, according to *UPS*, delivery time would be dependent on the destination address and the day of the week shipped.

Further, the *UPS* reference teaches that, notwithstanding the name of a delivery service, delivery guarantees may depend on the day of the week on which shipping occurs. For example, some UPS® delivery services support Saturday delivery; whereas others do not; Sunday delivery options are not indicated in *UPS* for any of the UPS® delivery services. *Compare, e.g., UPS*, p. 2 (describing, for UPS Next Day Air Early A.M.®, both a Saturday Delivery option and a Saturday Pickup option) and *UPS*, p. 4 (describing, for UPS Next Day Air®, both a Saturday Delivery option and a Saturday Pickup option), *with UPS*, p. 6 (describing, for UPS® 2nd Day Air A.M.®, a Saturday Pickup option, but with no mention of a Saturday Delivery option).

That is, assuming that the delivery address is to one of "most metropolitan addresses" to which delivery would be "Guaranteed Two-Day by 12 Noon" (*see, UPS*, p. 6), if a package were sent on a Thursday via UPS® 2nd Day Air A.M.®, even though the delivery service name "UPS® 2nd Day Air A.M.®" may imply that the delivery would be made by the second day, a Saturday, following the Thursday shipment day,

according to _UPS_, Saturday delivery would not be available. Because a Saturday delivery option is not available for the "UPS® 2nd Day Air A.M.®" delivery service, then delivery for a package sent on a Thursday using the "UPS® 2nd Day Air A.M.®" delivery service would not be available until the next day available for deliveries for the "UPS® 2nd Day Air A.M.®" delivery service -- which, because neither Saturday nor Sunday are indicated in _UPS_ as delivery days for the "UPS® 2nd Day Air A.M.®" delivery service, would therefore not occur until, _e.g._, the following Monday, or if the following Monday were a holiday, then possibly not until the following Tuesday.

The above-described variations in delivery days and times for various UPS® delivery services as dependent on specific shipping and/or delivery parameters is evidence that the mere listing of a delivery service by name, and/or a general statement of guarantee, are not a conclusive indication of a delivery date or time for a particular parcel to be shipped to a particular address.

The _UPS_ reference shows a "Quick Cost Calculator" link on each separate UPS® delivery service website page. For example, for the UPS Next Day Air Early A.M.® delivery service, _UPS_ states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS Next Day Air Early A.M." _UPS_, p. 2. As another example, for the UPS Next Day Air® delivery service, _UPS_ states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS Next Day Air." _UPS_, p. 4. As a further example, for the UPS 2nd Day Air A.M.® delivery service, _UPS_ states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS 2nd Day Air A.M." _UPS_, p. 6. Yet further, for the UPS 2nd Day Air® delivery service, _UPS_ states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS 2nd Day Air." _UPS_, p. 8. For the UPS 3 Day Select® delivery service, _UPS_ states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS 3 Day Select." _UPS_, p. 10. For UPS Ground, _UPS_ states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS Ground Service." _UPS_, p. 12.

However, it is respectfully submitted that neither the _UPS_ Quick Cost Calculator link, nor the corresponding UPS® Quick Cost Calculator webpage, as depicted, for

example, in Exhibits D, G, and K to the *Smith Decl.*, appear to have provided any entry for a shipping date or any determination of any shipping-date dependent delivery date (or delivery time for that matter) in connection with any calculation of shipping rates, at least not during the time preceding the present invention. *See, e.g., Smith Decl.*, ¶¶ 12, 17, and 20-21.

Yet further, even if it were assumed for the sake of argument only, that the *UPS Quick Cost Calculator* would allow the input of a particular shipping date and would then determine a shipping-date-dependent delivery date and/or delivery time, it is respectfully asserted that even once a *UPS* user had obtained a set of rates and availability and delivery dates and/or times for various delivery services offered by UPS®, doing so would not have provided the *UPS* user with rates and availability and delivery dates and/or times, for various delivery services offered by any other carrier.

Further still, it is respectfully asserted that *Kara* does not compensate for the elements missing from the other cited references. As compared to the combination of limitations claimed by Claim 15 (and the Claims on which it depends), *Kara* discloses a system that requires that a user first pre-select a class and/or delivery "urgency". FIG. 7 of *Kara* depicts process element 712 that is labeled "Class/Urgency" and that contains the description "Select from different choices: first, third, fourth, bulk rate, priority mail, air mail, same day, overnight, next day, 2 days, 3 days". FIG. 8 of *Kara* depicts a display interface with a box 802 providing fields for Weight (Pounds and Ounces), Zone, Class, and a choice of Domestic or International. FIG. 8 of *Kara* also depicts a box 807, labeled as "Urgency" and containing the choices of "Same day", "Overnight", "Next day", "2 Days", "3 Days", and "Immaterial". The specification of *Kara* explains that, "[i]n step 712, the user selects the class and/or urgency of the item from the choices shown in box 802 and 807. It shall be appreciated that ones of the selections of class and urgency may substantially overlap and, therefore, selection of such an option from one of boxes 802 or 807 may also make a corresponding selection in the other one of boxes 802 or 807." *Kara*, col. 21, lines 1-7.

Kara discloses that "class and urgency information may be different for each of the shipping service providers and, accordingly, selection of a particular class[ ] or urgency criteria may be based at least in part on the particular shipping service

provider(s) for which the user wishes the ... program to calculate the necessary

postage.... Alternatively, the class and urgency information may be presented for

selection generically, as shown in FIG. 8, and the ... program operate to determine the

corresponding fees for each of the particular shipping service providers automatically."

Kara, col. 21, lines 8-20.

Whether the class and urgency information available for selection by the user is

presented "generically" (as depicted in FIG. 8 of _Kara_), or is available for "selection ...

based ... on the particular shipping service provider", _Kara_ explains that, only after a

selection of class and/or urgency is made are fees calculated and displayed.

> In order to present the user with information from which to make an informed
> choice as to a particular shipping service provider by which to ship the piece of
> mail or other item, the E-STAMP program may calculate the fees associated with
> a plurality of the available shipping service providers. Accordingly, the user may
> select shipping service providers of interest (not shown) in order to allow the E-
> STAMP program to determine the fees for only those shipping service providers.
> Thereafter, the E-STAMP program may calculate and display fees associated
> with shipping the item via the selected shipping service providers according to
> the desired shipping and/or delivery parameters, i.e., class, urgency, etc. Where
> a selected shipping service provider does not provide a desired shipping and/or
> delivery parameter, the E-STAMP program may indicate such and provide the
> fees for a service offered by that particular shipping service provider most near
> that desired by the user.
>
> However, in the preferred embodiment, the E-STAMP program automatically
> calculates the fees for each shipping service provider offering service
> commensurate with the desired shipping and/or delivery parameters.
> Additionally, the E-STAMP program may indicate other ones of the shipping
> service providers which do not provide a desired shipping and/or delivery
> parameter and provide the fees for a service offered by that particular shipping
> service provider most near that desired by the user, as well as indicate how their
> service differs from that desired.

Kara, col. 22, lines 20 – 48.

FIG. 8 of _Kara_ depicts box 808 which is labeled "Selection & Comparison". In

box 808 of FIG. 8 of _Kara_, the carriers "US Post", "Federal Express", "DHL", "UPS",

"Purolator", and "Emery" are listed. To the left of each carrier is a box, with which to

select one of the carriers. _See Kara_, col. 22, lines 53-54 ("...the user selects a

particular shipping service provider, such as by checking a box associated therewith

(shown in box 808) ...").. To the right of each carrier (shipping service provider) in box 808 is a dollar field for display of a shipping rate. _Kara_, FIG. 8. Importantly, only one dollar field is indicated per carrier.

Considering all of the various disclosures of _Kara_, it is respectfully asserted that _Kara_ fails to disclose any determination or identification of shipping-date-dependent delivery dates or times as claimed by Claim 15. Further, it is respectfully asserted that _Kara_ does not display any shipping-date-dependent delivery dates or times and would have to be reprogrammed to do so. Yet further, even if it were assumed for the sake of argument only that _Kara_ could display shipping-date-dependent delivery dates and times, because _Kara_ requires a pre-selection of an "urgency," it is respectfully asserted that even if shipping-date-dependent delivery dates and times were made available to _Kara_, that _Kara_ would only display dates and times for a pre-selected urgency, and not for "... each respective delivery service selected by the particular online merchant for each respective carrier of the set of carriers for potential use by the consumer ..." as claimed by Claim 11 on which Claim 15 ultimately depends.

Still further, it is respectfully asserted that there is no teaching or suggestion as required under MPEP §706.02(j), to combine _Barnett_ with the other cited references. _See also_ MPEP §2143. In particular, it is respectfully submitted that _Barnett_ is not in any way related to product returns, shipping, or calculating rates.

According to the Office Action, "[i]t would have been obvious to ... to display the calculation of shipping rates, calculated by Kara, UPS® and FedEx®, in the format of a plurality of cells with date on one axis and time on another, as disclosed by Barnett, in order to provide a multi-layers system wherein different categories can be overlaid on one another providing a single integrated display that allows a user to order or purchase a system based on the calendar day and time ..." (citing _Barnett_, col. 2). _Office Action_, Topic No. 27, p. 9.

It is respectfully submitted that "... provid[ing] a multi-layered calendaring system wherein _events belonging to different categories_ and selected by a user can be overlaid on one another in a single integrated calendar ..." (as disclosed in _Barnett_, col. 2, lines 26 – 29 (emphasis added)), does not provide any express or implied teaching or

suggestion as indicated by *MPEP* §706.02(j) to combine *Barnett* with the other cited

references with respect to the subject matter of *e.g.*, Claim 15, which recites:

> ... each of said cells comprises an intersection that coincides with a delivery date and a delivery time, and each respective shipping rate being displayed in a respective cell that coincides with an intersection of a particular delivery date and a particular delivery time by which a particular delivery service by a particular carrier would deliver the particular respective item of merchandise to the particular online merchant for the respective shipping rate relevant to a particular shipping date.

Further, it is respectfully asserted that none of the other cited references provide

any express or implied teaching or suggestion as indicated by *MPEP* §706.02(j) to

combine *Barnett*.

Yet further, it is respectfully asserted that the reason asserted by the Office

Action for combining *Barnett* with the other cited references to "... provide a multi-layers

[sic] system wherein different categories can be overlaid on one another providing a

single integrated display that allows a user to order or purchase a system based on the

calendar day and time (See Barnett, column 2) ..." (*Office Action*, Topic No. 27, p. 9), is

not relevant to the claimed display of shipping-date-dependent delivery dates or times.

In particular, it is respectfully asserted that Claim 15 is directed to a display of

rates by various delivery services and various carriers for a *single event, i.e.,*

"...deliver[ing] the particular respective item of merchandise to the particular online

merchant ..." and that the dates and times are determined according to a particular

shipping date. Therefore, it is respectfully asserted that *Barnett* is not properly combined

with the other cited references and that, therefore, Claim 15 of the present application is

non-obvious in view of the references of record and is in condition for allowance.

Yet further, it is respectfully submitted that even if it were assumed for the sake

of argument only that *Barnett* was properly combined with the other references, it is

respectfully asserted that *Barnett* does not disclose any display of rates by the *Barnett*

system.

The subject matter of *Barnett* is calendaring, not rates. More specifically, *Barnett*

discloses a "... computer-implemented method and system for generating and

displaying a calendar containing user-selected events from user-selected categories."

Barnett, Abstract. Figure 9 of *Barnett* displays a user-customized week-view calendar of events. According to the disclosure of *Barnett*, the week-view calendar of events reflects a user's selection of categories of events. *See Barnett*, FIG. 9; *Barnett*, col. 12, lines 16-21. Figure 8 of *Barnett* shows a month-view of a user-customized calendar. *See Barnett*, FIG. 8; *Barnett*, col. 11, lines 36-38. Figure 10 of *Barnett* shows a day view. *See Barnett*, FIG. 10; *Barnett*, col. 12, lines 42-43. None of the various calendars depicted in *Barnett* depict any display of rates. Moreover, there is simply no disclosure in any of the Figures of *Barnett*, or in the disclosure of *Barnett*, that prices for the various calendared events are displayed in any of the *Barnett* calendars or schedules.

It is true that *Barnett* discloses that "[o]nline purchasing and related actions can be associated with each event" (*Barnett*, Abstract). However, *Barnett* explains that the referred-to purchases would be done using links. *See, e.g., Barnett*, col. 2, lines 65-67 ("In addition, purchases of products, services, or tickets can be effected using links associated with displayed events."); *see also, e.g., Barnett*, col. 14, lines 13-17 ("In another embodiment, a link may be provided for making a purchase associated with a particular event. For example, if the event is a concert, a link to an on-line ticketing service maybe provided, for purchasing tickets to the concert."). It is respectfully submitted that the absence from the disclosure of *Barnett* of a display of price for a calendared event, and the disclosure of *Barnett* that a link to a separate service may be provided for making a purchase associated with a calendared event are evidence that *Barnett* did not contemplate that the system of *Barnett* would itself associate a price with an event calendared by the *Barnett* system.

Further, even assuming for the sake of argument that it could be argued that *Barnett* somehow suggested showing rates, it is respectfully asserted that the rates that *Barnett* might display would be for the various events calendared, not as a cross-comparison of rates for a single event such as the single event of a shipment of a return item to which Claim 15 (and the Claims on which Claim 15 depends) are directed.

Yet further, as compared to the limitations recited by Claim 15, it is respectfully asserted that FIG. 9 of *Barnett* discloses a display of an identification of a pre-scheduled event at an intersection that coincides with a pre-scheduled date and time for the

particular event. That is, _Barnett_ does not determine a schedule for an event. Rather, the events that are displayed by _Barnett_ have already been pre-scheduled.

As distinguished from the display of pre-scheduled events in _Barnett_, it is respectfully asserted that an exemplary embodiment of the limitations of Claim 15 would result in a customized display of rates that would be calculated and displayed on a schedule of delivery dates and delivery times that would be determined relevant to a particular shipping date, according to the parameters of the particular item being returned, and according to pricing rules for the particular carriers that had been pre-selected by a merchant.

For the above-given reasons, it is respectfully submitted that even assuming for the sake of argument only, that _Barnett_ discloses rates, the combination of _Kara_, _Barnett_, _UPS_ and _FedEx_ would not result in the combination of limitations recited by Claim 15 (and the Claims on which it depends).

Accordingly, it is respectfully asserted that Claim 15, and the Claims that depend on Claim 15, namely, Claims 16-21, are therefore patentably distinct from, and patentable over, the combination of _Barnett_ with _UPS_, _FedEx_ and _Kara_ (and for the reasons described above for Claim 1, from _Schwab_, _Seigel_ and _Junger_), and are in condition for allowance.

CONCLUSION

For the above-given reasons and for the authorities cited above, it is respectfully asserted that none of _Schwab_, _Siegel_, _Kara_, _Junger_, _UPS_, _FedEx_, _Barnett_, or any other reference of record, whether considered alone or in combination, disclose, anticipate, teach or suggest all of the limitations of the rejected Claims.

Therefore, for the foregoing reasons, it is respectfully asserted that the invention disclosed and claimed in the present application is not fairly taught by any of the references of record, taken either alone or in combination and that the application is in

condition for allowance. Accordingly, it is respectfully requested that the present application be reconsidered and allowed.

Respectfully submitted,
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